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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,607	07/24/2002	Susan Joy Cooper	JMYT-252US	5114

7590 03/02/2007
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EXAMINER

MERCADO, JULIAN A

ART UNIT	PAPER NUMBER
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1745

MAIL DATE	DELIVERY MODE
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03/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/018,607	COOPER ET AL.	
	Examiner	Art Unit	
	Julian Mercado	1745	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-13 and 15-52.
Claim(s) withdrawn from consideration: 14.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: PTOL-413 (Interview Summary)


 BRIAN K. O'HARA
 SUPERVISOR, APPEAL EXAMINER

Advisory Action

This Advisory action is responsive to applicant's remarks and arguments filed on January 19, 2007.

Applicant's remarks and arguments will be entered upon filing of a Notice of Appeal and an Appeal Brief. The arguments submitted have been fully considered, however they are not found persuasive for the following reasons:

In response to the motivation to combine the teachings of Wilkinson et al. and Petrow et al. as set forth in the prior Office action, applicant submits that the reason submitted by the examiner—"to greatly improve catalytic efficiency tenfold", is not an accurate reading of Petrow et al., insofar as both materials in the comparison were carbon and the difference in the materials tested was the form of platinum. This argument is not persuasive, as the examples in Petrow et al. are not limited to carbon. In col. 5 line 54, Petrow et al. specifically teach that an "additional example is concerned with deposition or adhering to a refractory non-conductive substrate of *alumina*." (emphasis added) As to the catalyst in Petrow et al. acting as an electrocatalyst and not a gas phase catalyst as required by dependent claim 2, this argument is not persuasive as the catalyst in Petrow et al. provides "a significantly improved *oxidation catalyst*...". Emphasis added, see col. 5 line 64 et seq., also see col. 6 line 65 et seq. The catalyst in Petrow et al. appears to be no different from the catalyst disclosed in applicant's specification on page 5 thereof, first full paragraph, which discloses a gas phase catalyst tending "towards a more oxidising [sic], i.e. higher potential" with the ability to selectively "oxidise CO even in the presence of oxygen."

Furthermore, the form of platinum is in fact *exactly the same* for three of the four examples of platinum on alumina disclosed by Petrow et al., with the difference being amounts of 200 mg, 500 mg, and 2000 mg, with the fourth example being 200 mg of platinum further reduced with H₂. See col. 5 line 54 to col. 6 line 44, with emphasis on col. 5 line 57, col. 6 lines 13-15 and line 24. The platinum on alumina results in “very uniform distribution of fine platinum particles through the alumina surface structure” along with reduced ignition temperatures. See col. 5 lines 61-62 and col. 6 line 5 et seq., line 18 et seq. and line 27 et seq.

On February 28, 2007 during an applicant-initiated phone interview, Applicant's attorney emphasized that Petrow et al. does not provide the needed motivation to modify Wilkinson et al. to achieve the claimed invention. The examiner has considered this line of argument but is not found persuasive. Petrow et al. in col. 1 lines 47-49 specifically teach that “[s]till another object is to provide novel catalytic structures *to which* such finely deposited platinum particles are adsorbed and adhered.” (emphasis added) By “to which”, the patentees are clearly referring to structures including both carbon, non-conductive alumina, as well as other refractory oxides, as part of the disclosed invention. See col. 6 line 47 et seq. To say that Petrow et al. would at best motivate selection of the particular form of platinum is, in the opinion of the examiner, a narrow interpretation which improperly excludes the critical and related portions of the reference such as the types of catalytic structures to which the platinum particles are adhered. Furthermore, as stated in the preceding paragraph, selection of the particular form of platinum is only required when the substrate is carbon; when the substrate is alumina, the skilled artisan would instead focus on or, in the patentees own words, be “concerned with deposition or adhering to a refractory non-conductive substrate of alumina.” See col. 5 lines 54-55. The skilled artisan

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certainly cannot be concerned with the step deposition without also being concerned with the type of substrate being deposited on.

Finally, it is well accepted in case law that the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature, possibly "Jam", is written over a circular stamp. The signature is in black ink and is somewhat stylized. The stamp is also in black ink and is partially obscured by the signature.